



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,703	02/05/2004	William M. Colone	297912002102	5606

25224 7590 05/31/2005  
MORRISON & FOERSTER, LLP  
555 WEST FIFTH STREET  
SUITE 3500  
LOS ANGELES, CA 90013-1024

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/772,703

Applicant(s)

COLONE, WILLIAM M.

Examiner

Walter B. Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***REPEATED REJECTIONS***

***Claim Rejections - 35 USC § 102***

1. The 35 U.S.C. 102 rejection of claim 42 made of record in paragraph 2 of the previous Office Action mailed December 23, 2004 has been repeated for the reasons previously made of record.

***Claim Rejections - 35 USC § 103***

2. The 35 U.S.C. 103 rejection of claims 43-45 made of record in paragraph 4 of the previous Office Action mailed December 23, 2004 has been repeated for the reasons previously made of record.

3. The 35 U.S.C. 103 rejection of claim 46 made of record in paragraph 5 of the previous Office Action mailed December 23, 2004 has been repeated for the reasons previously made of record.

***Response to Arguments***

4. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 42 presented on pages 2 and 3 of the Response filed March 11, 2005 have been fully considered but are not persuasive.

In the paragraph bridging pages 2 and 3 of the Response filed March 11, 2005, Applicant argues that the method limitations identified in paragraph 2 of the previous Office Action mailed December 23, 2004 should be given patentable weight and quotes *In re Hallman* (1981, "to the extent that the process limitations distinguish the products over the prior art, they must be given the same consideration as traditional product characteristics"), but the limitations that

Art Unit: 1772

“distinguish the product[]” (i.e. that positively recite structural limitation/s) have been given full consideration (the recited minimum ratio of expanded diameter/original diameter of the tube was treated for the structure positively recited via the recited minimum ratio of expanded diameter/original diameter property). The recitation that does not positively recite any structural limitations (i.e. “is sintered...ratio of 1.0”) was not given patentable weight because it does not positively recite any structural limitations.

Applicant addresses the position of the Office set forth in paragraph 2 of the previous Office Action mailed December 23, 2004 regarding the involvement of the claimed radial expansion ratio with an intermediate product, but ignores the characterization of the claimed radial expansion ratio by the Office as a method limitation (in paragraph 2 of the previous Office Action mailed December 23, 2004). The claimed radial expansion ratio is a method limitation because, as the language of claim 42 reads, the radial expansion ratio is the ratio of the diameter of the tube prior to “pre-dilat[ion]” (line 3 of claim 42) to the diameter of the “contracted” tube (line 5 of claim 42) after the tube is “expanded” and subsequently “contracted” (lines 4 and 5 of claim 42): the recitation that the radial expansion ratio of the tube is 1.0 does not contribute anything further to the recitation that the “contracted diameter” of the tube is “substantially the same as [the] original inner diameter”, which is a portion of the method recitation “is sintered...ratio of 1.0” that has not been given patentable weight because the equivalent recitations that the “contracted diameter” of the tube is “substantially the same as [the] original inner diameter” and that the radial expansion ratio of the tube is 1.0 depends results from the sintering method step.

In regard to the involvement of the claimed radial expansion ratio with an intermediate product as discussed in paragraph 2 of the previous Office Action mailed December 23, 2004,

Art Unit: 1772

Applicant argues that the test results disclosed in the specification are directed to a final product, and not an intermediate product, but the language of claim 42 requires that the claimed radial expansion ratio is the ratio of the diameter of the tube prior to “pre-dilat[ion]” (line 3 of claim 42) to the diameter of the “contracted” tube (line 5 of claim 42) after the tube is “expanded” and subsequently “contracted” (lines 4 and 5 of claim 42); therefore, the language of claim 42 requires that the claimed radial expansion ratio is the ratio of the diameter of an intermediate product to the diameter of the final product, and is not a property calculated solely from measurement of the diameter of the final product. Applicant argues that the claimed sintering step “clear[ly] distin[guishes]” Applicant’s product from the article of Gore, but the sintering method step does not structurally differentiate the claimed article from the article of Gore because it is method step.

5. Applicant’s arguments regarding the 35 U.S.C. 103 rejections of claims 43-46 presented on page 3 of the Response filed March 11, 2005 have been fully considered but are not persuasive. Applicant’s arguments depend solely upon Applicant’s arguments regarding the 35 U.S.C. 102 rejection of claim 42 presented on pages 2 and 3 of the Response filed March 11, 2005, which have been addressed above in this Office Action.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1772

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

05/25/05

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

5/26/05